FILE COPY

Supreme Court, U. S.
FILED
JUN 13 1973
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972.

No. 72-1534

THE D. S. BROWN COMPANY AND
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

PETITIONERS' BRIEF IN REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

MATTHEW C. THOMPSON,
JOHNSTON, KEIL, THOMPSON
& SHURTLEFF,
135 South La Salle Street,
Chicago, Illinois 60603,
Attorneys for Petitioners.

Gunthorp-Warren Printing Company, Chicago • 346-1717

IN THE

Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-1534.

THE D. S. BROWN COMPANY AND
DELMONT D. BROWN,

Petitioners,

vs.

ACME HIGHWAY PRODUCTS CORPORATION,

Respondent.

PETITIONERS' BRIEF IN REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

Petitioners submit this Reply Brief to cite errors of fact and law in Respondent's Brief filed in opposition to the Petition for Certiorari.

There is no basis in the record for the last sentence on page 2 of Respondent's Brief. Petitioners' expert, Professor John P. Cannon, gave no testimony at all, let alone admissions, that any of the Petitioners' accused bridge seals[1] adopted the "basic

1. Cross-sections represented in Figs. 5-9 of the opinion of the Court of Appeals, Petition Appendix, p. A5.

features" of the patented invention. His testimony was to the contrary.

The contention on page 4 of Respondent's Brief that the question of infringement was basically one of law or a mixed question of law and fact which the Court of Appeals was free to decide is contrary to this Court's holding in *Graver Tank & Mfg. Co., Inc. et al.* v. *Linde Air Products Co.*, 339 U. S. 609-10. This Court has ruled that a finding of equivalents is a determination of fact, stating at 35 U. S. 609:

> "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence."

The Court of Appeals for the Sixth Circuit, up to the time of its opinion in this litigation, followed this rule of law. *U. S. Plywood Corp.* v. *General Plywood Corp.*, 370 F. 2d 500, 152 USPQ 80 (CA 6, 1967), cert. den. 389 U. S. 820; *King-Seeley Thermos Co.* v. *Millersville Mfg. Co.*, 412 F. 2d 318, 162 USPQ 257 (CA 6, 1969).[2]

It is submitted that the Court of Appeals for the Sixth Circuit did not apply conventional law in its ruling of infringement by Petitioners' five bridge joint seals and one pavement joint seal and that the Court of Appeals erred in both fact and law in its

2. Similar holdings are found in decisions in other circuits. *Porter-Cable Machine Co.* v. *Black & Decker Mfg. Co.*, 402 F. 2d 517, 159 USPQ 65 (CA 4, 1968); *National Athletic Supply Corp.* v. *Tone-O-Matic Products, Inc.*, 421 F. 2d 407, 164 USPQ 330 (CA 5, 1970); *Hadco Products, Inc.* v. *Frank Dini Co., Inc.*, 401 F. 2d 462, 159 USPQ 321 (C A 3, 1968); *Marvin Glass & Assoc.* v. *Sears, Roebuck & Co.*, 448 F. 2d 60, 171 USPQ 263 (CA 5, 1971).

ruling of infringement. The departure from established law, *i.e.*, that a finding of equivalence is determination of fact, is further cause for fresh review of the doctrine of equivalents by this Court.

Respectfully submitted,

MATTHEW C. THOMPSON,
JOHNSTON, KEIL, THOMPSON
& SHURTLEFF,
135 South La Salle Street,
Chicago, Illinois 60603,
Attorneys for Petitioners.